IN THE CLAIMS

Please add new Claim 20 as follows:

20. The method of Claim 1 wherein said step of measuring a first amount of time between transmission of the first information frame and receipt of the first response uses a timer operating in response to a clock, and wherein said response time value is a response time value of said timer.

REMARKS

Claims 1-19 are pending in the Application.

Claims 1-19 stand rejected.

New Claim 20 has been added herein.

I. REJECTION UNDER 35 U.S.C. § 102

Claims 1-5 stand rejected under 35 U.S.C. § 102(b) as being anticipated by *Waclawsky* (U.S. Patent 5,802,302). Applicant respectfully traverses these rejections.

As the Examiner is aware, for a §102 rejection the Examiner must show where each and every limitation of the claim is taught within the cited prior art. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the... claim." Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236 (Fed. Cir. 1989). *See* MPEP 2131. The Applicant respectfully contends that the Examiner has not shown that *Waclawsky* teaches each and every limitation with respect to Claims 1-19.

The system claimed in present Claim 1 is not identical to that disclosed by *Waclawsky, et al.*, and in fact, *Waclawsky, et al.* have taken an entirely different approach

to calculating response time. Claim 1 is directed to measuring a first amount of time between transmission of the first information frame and receipt of the first response. Moreover, this response time value can be modified in response to measured amount of time. In contrast, *Waclawsky, et al.* count bits being exchanged across the network to calculate response time. *Waclawsky, et al.* specifically states that their system does not use a clock in generating response time. Please see Column 3, lines 2-4 and lines 60-65. Applicant respectfully notes, that the Block 18 identified by the examiner as a clock, is in actuality a bridge (*Waclawsky, et al.*, col. 3, line 41).

Moreover, the Examiner has identified no teaching in *Waclawsky, et al.* directed to the step of selectively modifying a response time value. The Examiner relies on disclosure in *Waclawsky, et al.* which teaches, in its entirety, the method of *Waclawsky, et al.* "will lower costs and improve the accuracy of measuring and modifying performance." (*Waclawsky, et al.*, col. 2, lines 4-8.) Thus, the express terms of the relied-upon teaching, the Examiner has not shown that *Waclawsky, et al.* the aforesaid step of the method of Claim 1.

With respect to Claim 2, the Examiner contends that *Waclawsky, et al.* "disclose[s] incrementing an initial response value by time or clock resolution value, to form the response time value." The Examiner identifies no teaching whatsoever in *Waclawsky, et al.* to support the Examiner's contention. Moreover, the clock relied upon by the Examiner, reference numeral 18 in FIGURE 1 is in actuality a bridge between a token ring and a communications network. (*Waclawsky, et al.*, col. 3, lines 27-28, in FIGURE 1.) Therefore, because the Examiner has failed to demonstrate that *Waclawsky, et al.* teaches the invention of Claim 2, Claim 2 is allowable under 35 U.S.C. § 102(b) over *Waclawsky, et al.*

With respect to Claim 3, directed to the method of Claim 2 in which the initial response time value is incremented up to a maximum response time value, the Examiner asserts that *Waclawsky, et al.* "disclose[s] incremented up to a maximum response time

value." The Examiner relies on the teaching in *Waclawsky, et al.* at column 2, lines 58-66. In fact, *Waclawsky, et al.* teaches a digital filter having counters which count the number of bits transmitted on the media, and includes no reference to incrementing anything up to a maximum response time value. (*Waclawsky, et al.*, col. 2, lines 53-62.) For this reason, and for the reasons discussed hereinabove in conjunction with Claim 2, as well as those discussed hereinbelow in conjunction with Claim 6, the Examiner has provided no teaching in *Waclawsky, et al.* directed to the invention of Claim 3. Consequently, Claim 3 is allowable under 35 U.S.C. § 102(b) over *Waclawsky, et al.*

Claim 4 is directed to the method of Claim 2 in which the initial response time value is a default value. The Examiner asserts that *Waclawsky, et al.* disclose[s] "the initial response time value is a default value or standard format." The disclosure in *Waclawsky, et al.* relied upon by the Examiner, in fact, teaches that the response, that is, message, that comes back is in a standard network frame format, which may, *inter alia*, consist of a flag field. (*Waclawsky, et al.*, Column 3, lines 42-44.) Thus, the Examiner has incontrovertibly failed to identify disclosure in *Waclawsky, et al.* teaching the express limitation of Claim 4. Consequently, the Examiner has not shown where each and every limitation of the Claim 4 is taught within the cited prior art. MPEP § 2131. Hence, Claim 4 is allowable under 35 U.S.C. § 102(b) over *Waclawsky, et al.*

Furthermore, as the Examiner is well aware, a dependent claim incorporates each and every element of its associated independent claim. Applicant additionally respectfully traverses the Examiner's rejections of claims 2-5 because *Waclawsky, et al.* fail to show the step of calculating a response time using a timer and selectively modifying a timer time value described in their associated independent claim. Therefore, the Applicant respectfully contends that claims 2-5 are allowable under 35 U.S.C. § 102(b) over *Waclawsky, et al.*

II. REJECTION UNDER 35 U.S.C. § 103

The Examiner has rejected claims 6-19 under 35 U.S.C. § 103(a) as being unpatentable over *Waclawsky, et al.* and further in view of *Carlson* (5,859,853). Applicant respectfully traverses these rejections.

The Examiner states that it would have been obvious to one with ordinary skills in the art at the time of the invention was made to combine *Waclawsky's* teaching with *Carlson's* teaching to achieve Applicant's claimed systems and methods. Under 35 U.S.C. § 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art are to be resolved. *Graham v. John Deere*, 383 U.S.1 (1966). The Examiner has failed to ascertain the differences between the prior art and the claims at issue. *See* MPEP 2141.

Additionally, when applying 35 U.S.C. § 103, the following tenants of patent law must be adhered to; a) the claimed invention must be considered as a whole; b) the references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combinations; c) the references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention, and d) reasonable expectation of success is the standard with which obviousness is determined. *Hodosh v. Block Drug Co., Inc.*, 229 U.S.P.Q. 182, 187 n.5 (Fed. Cir.1986).

To establish a *prima facie* case of obviousness, the Examiner must meet three criteria. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must be both found in the prior art, and not

based on the Applicant's disclosure. *In re Vaeck*, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); MPEP 2142.

The initial burden is on the Examiner to provide some suggestion of the desirability of doing what the inventor has done. When the motivation to combine the teachings of the references is not immediately apparent, it is the duty of the Examiner to explain why the combination of the teachings is proper. *See* MPEP 2143, 2143.01, 2143.02, 2143.03. Because the Examiner has failed to make a *prima facie* case of obviousness that all the claim limitations are taught or suggested by the prior art, namely that the prior art teaches of modifying the response time of a timer as a function of a time measurement between frame transmission and response return.

Claim 6 contains all the novel non-obvious limitations of Claim 1, of which *Waclawsky, et al.* teach away. The deficiencies of *Waclawsky, et al.* however are not remedied by the further consideration of *Carlson*. Specifically, while *Carlson* talks about changing the packet train length to track the packet traffic arrival rate, *Carlson* does not disclose or suggest dynamically changing the response time value. In *Carlson*, the time base stays the same and the packet length changes.

The Examiner has failed to make out a *prima facie* case. Furthermore, if an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious.

The Examiner has rejected Claims 7-19 on the same ground as Claims 1-6. Thus, Claims 7-19 are similarly allowable for the reasons set forth above, which are not repeated here for brevity and clarity.

No new matter has been added, merely amended to more particularly point out and distinctly claim the subject matter Applicant believes is inventive. Applicant respectfully submits that the Claims as they now stand are patentably distinct over the art cited during the prosecution thereof.

III. ADDED CLAIM 20

New Claim 20 has been added herein. As discussed hereinabove, *Waclawsky, et al.* specifically states that the system disclosed therein does not use a clock in generating a response time. (*Waclawsky, et al.*, col. 3, lines 2-4, and lines 60-65.)

IV. CONCLUSION

As a result of the foregoing, it is asserted by Applicants that the remaining Claims in the Application are in condition for allowance, and respectfully request an early allowance of such Claims.

Applicants respectfully request that the Examiner call Applicants' attorney at the below listed number if the Examiner believes that such a discussion would be helpful in resolving any remaining problems.

Respectfully submitted,
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